

UNITED STATES. CIRCUIT COURT. EASTERN
DISTRICT OF PENNSYLVANIA

October Sessions, 1900 No. 12

In Equity

Eldridge R. Johnson, Complainant
versus

Columbia Phonograph Company, General,
Defendant

RECORD, 1901 - 1902

U. S. Circuit Court. Eastern District of Pennsylvania.

Eldridge R. Johnson) October Sessions, 1900
versus) No. 12
Columbia Phonograph Co., General.) In Equity.

BILL, ANSWER AND DISMISSAL BY CONSENT

CIRCUIT COURT OF THE UNITED STATES,
EASTERN DISTRICT OF PENNSYLVANIA.

October Sessions, 1900. No. 12.

IN EQUITY.

ELDRIDGE R. JOHNSON,
Complainant,
v.
COLUMBIA PHONOGRAPH COMPANY GENERAL,
Defendant.

To the Honorable Judges of the Circuit Court of the United States for the Eastern District of Pennsylvania:

Eldridge R. Johnson, a citizen of the United States, and a resident of the city of Philadelphia, State of Pennsylvania, brings this his bill of complaint against the Columbia Phonograph Company General, a corporation organized and existing under the laws of the State of West Virginia, and doing business in and having its main office and place of business in the city of New York, State of New York, and having an office and a regular and established place of business in the city of Philadelphia, State of Pennsylvania, and doing business in the said city of Philadelphia, within the Eastern District of Pennsylvania.

And thereupon your orator complains and says:

1. That your orator Eldridge R. Johnson, formerly of the city of Camden, State of New Jersey, now a resident of the city of Philadelphia, State of Pennsylvania, was the origi-

*Filed
May 1901
Fannie Bell Clark*

nal, sole and first inventor of certain new and useful Improvements in Sound Recording and Reproducing Machines, which improvements were not known or used by others in this country before his invention thereof, and were not patented nor described in any printed publication in this or any foreign country before his invention thereof, and were not in public use or on sale in the United States for more than two years prior to his application for a patent therefor, and which had not been abandoned.

2. Your orator further shows unto your Honors that your orator, being as aforesaid, the first inventor and discoverer of the said new and useful Improvements in Sound Recording and Reproducing Machines, did on the first day of June, 1897, duly make application to the Honorable Commissioner of Patents at Washington, D. C., for letters patent of the United States for the said invention, and on the said date filed his said application with the said Honorable Commissioner of Patents in due and proper form, and thereafter duly fully prosecuted said application.

3. Your orator further shows unto your Honors that your orator being as aforesaid, the first inventor and discoverer of the said new and useful improvements, did on the twenty-third day of August, 1898, file with the Honorable Commissioner of Patents, at Washington, D. C., a divisional application, being a division of the said application duly filed June 1, 1897, for the improvements in Sound Recording and Reproducing Machines, and on the said date filed his said application with the said Commissioner of Patents in due and proper form, and thereafter duly and fully prosecuted the said applications; the said original application filed June 1, 1897, bearing the Serial No. 639,028 and the said divisional application filed August 23, 1898, bearing the Serial No. 689,291.

4. Your orator further shows that upon the said application Serial No. 639,028 of your orator, Eldridge R. Johnson,

letters patent of the United States were issued in the name of the said Eldridge R. Johnson, assignor by mesne assignments, hereafter recited, of a one-half interest to Thomas S. Parvin, of the City of Philadelphia, State of Pennsylvania, in due form of law, and in the name of the United States of America, under the seal of the Patent Office of the United States, signed by the Secretary of the Interior, and countersigned by the Acting Commissioner of Patents of the United States, and duly delivered, bearing date the seventh day of August, 1900, and numbered 655,556, whereby there was granted and secured to your orator, assignor of the one-half interest to the said Thomas S. Parvin, their legal representatives and assigns, for the term of seventeen years from the date of the said letters patent, and within the United States and its Territories, the full and exclusive right and liberty of making, constructing, using and vending the said invention and improvements, as set forth in the said letters patent, a duly certified copy of which is ready here in court to be produced, and by virtue whereof your orator, the said Eldridge R. Johnson, and Thomas S. Parvin, his assignee of a one-half interest by deed of assignment, hereinafter recited, became the sole owners of all rights and privileges granted and secured by the said letters patent, and of all rights in the premises.

5. Your orator further shows that upon the said application Serial No. 689,291 of your orator, Eldridge R. Johnson, being a divisional application of the said application Serial No. 639,028, filed June 1, 1897, letters patent of the United States were issued in the name of the said Eldridge R. Johnson, in due form of law, in the name of the United States of America and under the seal of the Patent Office of the United States, signed by the Secretary of the Interior, and countersigned by the Acting Commissioner of Patents of the United States, and duly delivered, bearing date the seventh day of August, 1900, and numbered 655,557, whereby there was granted and secured to your orator, his legal representatives and assigns, for the term of seventeen

years, from the date of the said letters patent and within the United States and its territories, the full and exclusive right and liberty of making, constructing, using and vending the said invention and improvements as set forth in the said letters patent, a duly certified copy of which is ready here in court to be produced, and by virtue whereof your orator become the sole owner of all rights and privileges granted and secured by the said letters patent, and of all rights in the premises.

6. Your orator further shows that on and prior to the eighteenth day of August, 1897, he being then the sole and exclusive owner of the said invention and of all rights to letters patent thereafter to be issued therefor, did, during the pendency of the said application, Serial No. 639,028, by instrument in writing duly executed, dated August 18th, 1897, recorded in the Patent Office, at Washington, D. C., in Liber , p. , etc., of Transfers of Patents, duly assign, transfer and set over unto Alfred Corning Clark, then of the city of New York, State of New York, his legal representatives and assigns, a one undivided one-half interest in and to the said inventions described and claimed in the said application for letters patent, Serial No. 639,028, filed June 1, 1897, and a one undivided one-half interest in and to all letters patent which should thereafter be granted therefor, as by reference to the said instrument, or a duly authenticated copy thereof, in court to be produced will more fully and at large appear.

7. And your orator further shows that your orator, Eldridge R. Johnson, and the said Alfred Corning Clark, being then the sole and exclusive owners of the said improvements in sound recording and reproducing machines as set forth in the said application for letters patent, Serial No. 639,028, filed June 1, 1897, each being the owner in equal shares, the said Alfred Corning Clark, during the pendency of the said application, by instrument in writing duly executed the eleventh day of November, 1897, and recorded in

the Patent Office at Washington, D. C., in Liber G., 58, p. 38 of Transfers of Patents, did assign, sell, transfer and set over unto Thomas S. Parvin, of the city of Philadelphia, State of Pennsylvania, his legal representatives and assigns, his one undivided one-half interest and all the entire right, title and interest of the said Clark in and to the said inventions and letters patent to be issued therefor, as by reference to the said instrument, or a duly authenticated copy thereof in court to be produced will more fully and at large appear.

8. Your orator further shows that your orator, the said Eldridge R. Johnson, and the said Thomas S. Parvin, being then the sole and exclusive owners of the said improvements in sound recording and reproducing machines as set forth in the said application for letters patent, Serial No. 639,028, filed June 1, 1897, and of Letters Patent No. 655,556, issued August 7, 1900, for the said invention upon the said application, each being the owner of equal shares, and letters patent of the United States No. 655,557 having been duly issued to your orator August 7, 1900 (for which the divisional application was duly filed August 23, 1898, Serial No. 689,291), the said Thomas S. Parvin, by instrument in writing duly executed the twentieth day of September, 1900, and recorded in the Patent Office, at Washington, D. C., in Liber , p. , etc., of Transfers of Patents, did assign, sell, transfer and set over unto your orator all the said undivided one-half interest of the said Parvin and all his entire right, title and interest in and to the said inventions and in and to the said Letters Patent No. 655,556, and any and all interest which he may have had or may have in and to Letters Patent No. 655,557, and in and to any and all letters patent for the said inventions, and all rights of action and interest therein whatsoever which the said Parvin had by reason of any and all infringements or violations of the said letters patent or of his interest therein and thereto pertaining, as by reference to the said instrument, or a duly authenticated copy thereof, in court to be produced will more fully and at large appear.

9. And your orator further shows unto your Honors, that by virtue of the premises your orator is now the sole and exclusive owner of the said Letters Patent No. 655,556 and No. 655,557, and of all rights of action thereto pertaining as will more fully and at large appear by reference to the said assignments, agreements and proofs in court to be produced.

10. And your orator further shows unto your Honors that he has expended large sums of money in practicing said inventions and improvements patented in the said Letters Patent No. 655,556 and No. 655,557, and in introducing the same into public use, and the same are of great commercial value and practical utility; that a great public interest has been manifested therein, and a large demand created for apparatus constructed in accordance with, or embodying the same, which demand your orator is ready and able to supply; that the public generally in all parts of the United States, having recognized and acquiesced in the facts that the said Eldridge R. Johnson was the first and original inventor of the said inventions, and that the patents No. 655,556 and No. 655,557, are good and valid; that the public have also acknowledged the claims of your orator to the exclusive rights of the said inventions under the said patents; and that, but for the infringements and wrongs hereinafter complained of, your orator would be now in peaceful possession and enjoyment of the said letters patent and inventions, and of the income derivable therefrom; and that your orator and the former joint owners in title have never acquiesced in any infringement of their rights in the premises at any time.

11. Yet, as your orator is informed and believes, and further shows unto your Honors, the Columbia Phonograph Company, General, the said defendant herein named, well knowing all the facts herein set forth, but contriving to injure your orator and to deprive him of the benefits and advantages which might and otherwise would, accrue to him

from the said patented devices, methods and things, has made, sold and used, and is now making and selling and using, apparatus and things relative to sound recording or reproducing, having and containing the devices and things patented in said Letters Patent No. 655,556 and No. 655,557, and employing methods covered by said letters patent, or in all substantial respects the same; the exclusive right to make, use and vend the same to others to use is legally vested in your orator.

12. And your orator further shows unto your Honors that notwithstanding the facts that the said defendant has been duly notified by your orator of your orator's rights in the premises, and of the fact that the said defendant was infringing the said letters patent of your orator, and that the said defendant should desist from such infringements, the said defendant has continued, and is still continuing, to the great and irreparable damage and injury of your orator, the manufacture, sale and use of the said infringing devices and things.

13. And your orator further shows, that he has given notice to the public that the said inventions are patented and has affixed, or caused to be affixed, to all apparatus and devices manufactured and sold under the authority of your orator the word "Patented," together with the day and year of the grant of the said patents, of which notice the said defendant has had full knowledge.

14. And so it is, may it please your Honors, that the said defendant, as your orator is informed and believes, without the license of your orator, and without any license whatsoever, against the will of your orator, and in violation of his rights, has made and sold, and intends to continue to make and sell, within the Eastern District of Pennsylvania, and elsewhere within the United States, said patented devices and things, each having and containing the said patented features, substantially the same in all material respects in

construction, operation and effect, as in your orator's said letters patent mentioned; and employing methods covered by said letters patent; and that the said defendant is largely advertising said infringements, to the great damage and injury of your orator, and that the said defendant refuses to pay unto your orator any of the profits which the said defendant has made by such unlawful manufacture and sale, or to desist from the further infringement of the said letters patent though requested so to do; all of which acts and doings are in violation of the exclusive rights and privileges, so as aforesaid, vested in your orator under and by virtue of the said letters patent; are contrary to equity and good conscience, tend to the manifest injury of your orator in the premises, and will, if said defendant is allowed to continue said infringements irreparably damage and injure your orator, depreciate or destroy the value of the exclusive franchises to which your orator is entitled under the patent aforesaid, and will deprive your orator of the benefits and advantages for the loss of which there exists no adequate legal remedy.

And your orator, therefore prays as follows :

I. That the said defendant be required by decree of this honorable court to account for and pay over to your orator such gains and profits as have accrued or arisen, or been earned or received by the said defendant, and all such gains and profits as would have accrued to your orator but for the unlawful doings of said defendant, and all damages your orator has sustained thereby.

II. That said defendant may be compelled by the order of this honorable court to deliver up to the judicial custody for destruction in manner to be provided for in said order, all infringing apparatus in the possession of, or under the control of said defendant.

III. That the said defendant, its associates, attorneys, servants, clerks, agents and workmen, may be perpetually enjoined and restrained, by a writ of injunction issuing out of

and under the seal of this honorable court; from directly or indirectly, making or causing to be made, using or causing to be used, selling or causing to be sold, any machine, method or apparatus embodying or constructed or operated in accordance with the inventions or improvements set forth in the letters patent aforesaid.

IV. That your Honors will grant unto your orator a preliminary injunction issuing out of and under the seal of this honorable court, enjoining and restraining the said defendant, its associates, servants, clerks, agents and workmen, to the same purport, tenor and effect as hereinbefore prayed for with regard to said perpetual injunction ; and

V. That this defendant be decreed to pay the costs of this suit; and

VI. That your orator may have such other and further relief as the equity of the case may require.

To the end, therefore, that the defendant may, if it can show why your orator should not have the relief prayed, and may full, true and direct answer make,—but not under oath, answer under oath being expressly waived,—according to the best and utmost of its knowledge, information, remembrance and belief, to the several matters hereinbefore averred and set forth; as fully and particularly as if the same were repeated paragraph by paragraph, and said defendant thereto specifically interrogated, may it please your Honors to grant your orator a writ of *subpœna ad respondendum*; issuing out of and under the seal of this honorable court, directed to said defendant, the Columbia Phonograph Company, General, commanding it to appear and make answer to this bill of complaint, and to perform and abide by such order and decree herein as to this court may seem just.

And your orator will ever pray.

ELDRIDGE R. JOHNSON.

HORACE PETTIT,

HOWARD W. HAYES,

Solicitors and of Counsel for Complainant.

STATE OF PENNSYLVANIA }
CITY AND COUNTY OF PHILADELPHIA. } ss.

Eldridge R. Johnson, being duly sworn, deposes and says that he is the complainant named in the foregoing bill; that he has read the same, and knows the contents thereof, and that the same is true of his own knowledge, save of the matters therein related to be alleged upon information and belief, and that as to those matters he believes it to be true.

ELDRIDGE R. JOHNSON.

Sworn and subscribed before me this 27th day of September, A.D. 1869.

CHARLES H. SPECKMAN,
Notary Public.

[SEAL]

In the Circuit Court of the United States
FOR THE EASTERN DISTRICT OF
PENNSYLVANIA.

ELDRIDGE R. JOHNSON

vs.

COLUMBIA PHONOGRAPH COMPANY,
GENERAL.

In Equity.
October Sessions,
1900, No. 12.

The answer of COLUMBIA PHONOGRAPH COMPANY,
GENERAL, defendant, to the bill of complaint of
ELDRIDGE R. JOHNSON, complainant.

This defendant answering the said complainant's
said bill of complaint, says:

This defendant admits that it is a corporation
organized and existing under the laws of the State of
West Virginia and doing business in and having a
regular and established place of business in the City of
Philadelphia within the said Eastern District of Penn-
sylvania. And this defendant further admits that the
complainant Eldridge R. Johnson is a citizen of the
United States and a resident of the City of Phila-
delphia in the State of Pennsylvania.

1.

This defendant, in answer to paragraph 1 of the said
Bill of Complaint, denies that the said Eldridge R.
Johnson invented improvements in Sound Recording

and Reproducing Machines as alleged in said Bill ; and denies that the same involved an inventive act, or that the said Johnson was the original or the first or the sole inventor or producer thereof ; and denies that the same were either new or useful at the date of his alleged invention ; and denies that the same were—or any part thereof was—patentable, affirming that the same were and was merely an aggregation of old and well known elements operating in an old and well-known manner ; and this defendant further denies that the said alleged improvements were not known or used by others in this country before the alleged invention thereof by the said Johnson, or had not been patented or described in any printed publication in this or any foreign country before his alleged invention thereof ; and denies that the said alleged improvements were not in public use or on sale in this country for more than two years prior to the date of his application for the grant of U. S. Letters-patent therefor, or that the same had not been abandoned.

As to the matters and things alleged in paragraph 2 of the bill, this defendant has no information save from said bill, and therefore leaves complainant to make such proof thereof as he can.

As to the matters and things alleged in paragraph 3 of the bill, this defendant has no information save from said bill, and therefore leaves complainant to make such proof thereof as he can.

This defendant admits that there issued on the 7th day of August, 1900, Letters-patent of the United States purporting to be granted to Eldridge R. John-

son and Thomas S. Parvin, bearing the number 655,556, and purporting to be for Improvements in Sound Recording and Reproducing Machines; however, this defendant is not advised save by the bill as to the remaining allegations in the said paragraph contained, and therefore leaves the complainant to make such proof thereof as he can; but this defendant expressly denies that by virtue of the premises the said Eldridge R. Johnson and Thomas S. Parvin became the sole owners of all rights and privileges granted and secured by the said Letters-patent and of all the rights in the premises, or of any rights and privileges whatever.

This defendant admits that there was issued on the 7th day of August, 1900, Letters-patent of the United States purporting to be granted to Eldridge R. Johnson, bearing the number 655,557, and purporting to be for Improvements in Sound Recording and Reproducing Machines; however, this defendant is not advised save by the bill as to the remaining allegations in the said paragraph contained, and therefore leaves the complainant to make such proof thereof as he can; but this defendant expressly denies that by virtue of the premises the said Eldridge R. Johnson, or anyone, became the sole owner of all rights and privileges granted and secured by the said Letters-patent and of all rights in the premises, or of any rights and privileges whatever.

As to the matters and things alleged in paragraph 6 of the bill, this defendant has no information save from said bill, and therefore leaves complainant to make such proof thereof as he can.

4

7

As to the matters and things alleged in paragraph 7 of the bill, this defendant has no information save from said bill, and therefore leaves complainant to make such proof thereof as he can.

8

As to the matters and things alleged in paragraph 8 of the bill, this defendant has no information save from said bill, and therefore leaves complainant to make such proof thereof as he can.

9

As to the allegations in paragraph 9 of the bill, touching complainant's title to the patents in suit, this defendant has no information save from the said bill, and therefore leaves complainant to make such proof thereof as he can ; but this defendant again denies that by virtue of the premises the complainant, or any one, has the exclusive right or any rights in the premises.

10

In answer to the allegations in paragraph 10 of the bill, this defendant is not informed, save by said bill, that the complainant or any one ever spent large sums of money or any sums of money in practicing said alleged inventions or improvements purporting to be patented in and by the said Letters-patent No. 655,556 and No. 655,557, and in introducing the same into public use ; and this defendant denies that the same or any substantial or material part thereof are or ever were of great commercial value or practical utility or of any value or utility whatever ; and denies that a great public interest or any interest has been manifested therein, or that a large demand or any demand has been created

for any apparatus constructed in accordance with or embodying the alleged improvements or any of them ; and as to what apparatus the complainant is ready and able to supply, this defendant is not advised save by the said bill of complaint, but upon information and belief avers that numerous suits in equity have been filed against this complainant seeking to enjoin him from the manufacture and sale of talking-machines and talking-machine supplies ; and this defendant further denies that the public generally, or any one, has ever recognized and acquiesced in the facts that the said Johnson was the first and original and sole inventor of the said alleged inventions and that the said patents or either of them were or are good and valid, or that the public or any one has also acknowledged the claims of this complainant to any rights under the said patents ; and this defendant further denies that save for the alleged infringements and wrongs by the said bill charged to be committed by this defendant, the complainant would be in peaceful enjoyment and possession of the said Letters-patent and of whatever income might be derivable therefrom, and that the owners of the said Letters-patent had never acquiesced in any alleged infringement of their alleged rights in the premises,—but in this regard this defendant shows upon information and belief that all persons familiar with the talking-machine art or engaged in the talking-machine business have long known that there is nothing novel or useful in the matters and things purporting to be covered by the claims of the said two Letters-patent, or by any claim thereof, and they have regarded with ridicule any claim on the part of this complainant to invention therein.

And in answer to paragraph 11 of the said bill, this defendant admits that it has dealt in talking-machines and appliances therefor relative to sound-recording and

reproducing ; but this defendant expressly denies that any one of such articles ever had or contained or now has or contains any device or thing patented, or purporting to be patented, in and by any claim or claims of said Letters-patent No. 655,556, or of said Letters-patent No. 655,557 ; and this defendant further denies that any claim of either of said patents covers or purports to cover any "method" as intimated by the said paragraph 11 ; and this defendant denies that it ever contrived to injure this complainant or to deprive him of any benefits and advantages which might accrue to him from the said patents or from any source; and this defendant again denies that by virtue of the premises the exclusive rights or any rights have ever become vested in this complainant.

12

And this defendant expressly and positively denies each and every allegation in paragraph 12 of the said bill contained.

13

In answer to paragraph 13, this defendant has no information save by the bill as to any notice given to the public by the complainant, or as to any article being by him or by his authority marked "patented," together with the date of the grant of any patent, and therefore leaves the complainant to make such proof thereof as he can ; but this defendant expressly denies any knowledge of the said alleged notice.

14

And in answer to the allegations of paragraph 14, this defendant denies that it has ever made or sold or used any device or article or apparatus or thing having or containing any feature patented to this complainant,

or purporting to be patented to him, or the same in any material respect as the articles and things purporting to be claimed in the said patents, or in either of them; and this defendant further denies that it has ever made any gains or profits to which this complainant is entitled, or that this complainant was ever damaged or injured by any act of this defendant, or that this defendant has ever been requested by this complainant to desist from any alleged infringement; this defendant again denies that this complainant is by virtue of the premises possessed of all exclusive rights and privileges under and by virtue of the said Letters-patent, or of any rights and privileges whatever; and denies that its actions are contrary to equity and good conscience; and denies that there is any equity whatever in complainant's said bill of complaint.

15

And for a further defense, this defendant affirms that not one of the various matters and things and combinations disclosed by the said Letters-patent and by each of them, is or ever was the result of an inventive act; and further affirms that each and every one of the same was not novel with the said Johnson, but on the contrary was well known in this country long before the alleged invention thereof by complainant, and had been in public use in this country for more than two years before the date of his application; and that the claims in each of the said patents contained are for aggregations of old and well known features, and affirms that the same are not now and never were capable of any useful employment whatever, but on the contrary are and were inoperative.

16

And for a further defense this defendant shows, and the same is manifest from a comparison of the said

Letters-patent here sued on with the original applications and the proceedings thereon in the Patent Office, that the alleged improvements and inventions purporting to be covered by the claims of the said patents are substantially and materially different from those originally disclosed by the application and applications as originally filed; and the defendant, again insisting that there is no novelty whatever in any of the matters and things claimed in and by the said patents, affirms that if there be any novelty at all in the claims as allowed the same is found in the new matter thus unlawfully and unmercifully introduced into the said applications during their pendency in the Patent Office; and that therefore the said patents are void and of no effect in law.

For a further defense this defendant avers, upon information and belief, that the said alleged inventions and each and all of them were not produced by this complainant alone, but were the joint product of one Alfred Corning Clark (then of Philadelphia, Pa., but now of Paris, France) together with this complainant; and that therefore the said patents are void and of no effect in law.

For a further defense this defendant avers, upon information and belief, that the said alleged inventions and each and all of them were not produced by this complainant alone, but were the joint product of one Reinhardt (then and now of Camden, New Jersey), together with this complainant; and that therefore the said patents are void and of no effect in law.

For a further defense this defendant shows that the matters and things purporting to be claimed by the patents in suit were fully disclosed and set forth, and were attempted to be claimed, in and by the various patents previously granted to the said complainant, either as sole patentee or conjointly with others, before the date of the issue of the patents here in suit, to wit, in U. S. Letters-patent No. 624,625, granted May 9, 1899, to the said Alfred Corning Clark and this complainant, upon a joint application filed Jan. 9, 1897, and in other patents granted in this country and in foreign countries, the dates and numbers of which are at present to this defendant unknown, but which it prays leave to introduce as part of this answer when ascertained; and that therefore the said patents are void and of no effect in law.

And for a further defense this defendant shows that by reason of having thus fully disclosed the said inventions in his said early patent and patents without claiming the same, the said Eldridge R. Johnson thereby abandoned the inventions purporting to be covered by the patents here sued on, and the same thereby became dedicated to the public; and therefore the said patents and each of them are void and of no effect in law.

And for a further defense to the said patent No. 655,557, this defendant avers that the matters and things purporting to be claimed thereby are fully disclosed in the said Letters-patent No. 655,556, and are attempted to be claimed thereby; wherefore the said Letters-patent No. 655,557 are void and of no effect in law.

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22

And for a further and special defense, this defendant shows *First*, that for the purpose of deceiving the public the descriptions and specifications filed in the Patent Office by this complainant were made to contain less than the whole truth relative to his alleged invention or discovery, or more than is necessary to produce the desired effect; and that the claims and each of them are ambiguous and insufficient, and that the specifications and each of them are not in such full, clear, concise and exact language as to enable others skilled in the art to make, construct, and use the alleged improvements; and, therefore the said patents are void and of no effect in law.

23

And for a further and special defense, this defendant shows *Second*, that the said patents and each of them were surreptitiously and unjustly granted for that which was in fact the invention or production of another, or others, who was or were using due diligence in reducing the same to practice,—namely, the said Alfred Corning Clark, the said Reinhardt, Joseph W. Jones, of New York City, Louis P. Valiquet, of New York City, and others, whose names and addresses are to this defendant now unknown, but which when discovered this defendant prays leave to insert in this Answer; and that therefore the said patents are void and of no effect in law.

24

And for a further and special defense, this defendant shows *Third*, that each and all of the said alleged improvements were fully set forth and disclosed in and by the following Letters-patent of the United States, that is to say:

- No. 227,679, granted May 18, 1880, to Thomas A. Edison ;
No. 341,214, granted May 4, 1886, to Bell & Tainter ;
No. 341,288, granted May 4, 1886, to Sumner Tainter ;
No. 375,579, granted Dec. 27, 1887, to Sumner Tainter ;
No. 386,974, granted July 31, 1888, to Thomas A. Edison ;
No. 393,466, granted Nov. 27, 1888, to Thomas A. Edison ;
No. 394,105, granted Dec. 4, 1888, to Thomas A. Edison ;
No. 394,106, granted Dec. 4, 1888, to Thomas A. Edison ;
No. 400,646, granted Apr. 2, 1889, to Thomas A. Edison ;
No. 409,003, granted Aug. 13, 1889, to Gianni Bettini ;
No. 409,005, granted Aug. 13, 1889, to Gianni Bettini ;
No. 415,499, granted Nov. 19, 1889, to Louis S. Clarke ;
No. 423,039, granted Mar. 11, 1890, to Thomas A. Edison ;
No. 424,914, granted Apr. 1, 1890, to John H. White ;
No. 440,155, granted Nov. 11, 1890, to Isaac W. Hey-singer ;
No. 450,740, granted Apr. 21, 1891, to Thomas A. Edison ;
No. 454,947, granted June 30, 1891, to Wm. Mc-Mahon ;
No. 500,281, granted June 27, 1893, to Thomas A. Edison ;
No. 531,690, granted Jan. 1, 1895, to Stewart D. McKelvey ;
No. 572,182, granted Dec. 1, 1896, to Ray ;
No. 633,226, granted Sept. 19, 1899, to Adolph Betzold ;
and the following German patent :
No. 82,934, granted Oct. 1, 1895, to Lahola & Sachs ;
and others whose respective dates and numbers are to

this defendant now unknown, but which when ascertained it prays leave to insert in this Answer; and therefore the said patents are void and of no effect in law.

And for a further and special defense this defendant shows also, that each and all of the said alleged improvements were fully set forth and disclosed in and by the following printed publications, that is to say, in and by each of the Letters-patent enumerated in the foregoing paragraph of this Answer, which were issued from and may be found in the Patent Office of the United States, at Washington, D. C.; and in and by other printed publications whose respective titles, dates, and places of publication, together with the places where the same may be found, and the pagings where such reference may be located, are at present to this defendant unknown, but which it prays leave when discovered to insert in this Answer.

And for further and special defense this defendant shows *Fourth*, that this complainant was not the first to produce the alleged improvements and inventions disclosed and purporting to be covered in and by the said Letters-patent and each of them; but that the same had been both known to others and also been produced and used by them long prior to the first alleged production thereof by the said Johnson, as follows:

By Thomas A. Edison, of and at Llewellyn Park, N. J.,
and elsewhere;
Chichester A. Bell, of and at Washington, D. C.,
and elsewhere;
Sumner Tainter, of and at Washington, D. C., and
elsewhere;

Emile Berliner, of and at Washington, D. C., and elsewhere;
Gianni Bettini, of and at the City of New York, and elsewhere;
Louis S. Clarke, of and at Pittsburgh, Pa., and elsewhere;
John H. White, of and at Washington, D. C., and elsewhere;
Wm. McMahon, of and at Rahway, New Jersey, and elsewhere;
Stewart D. McKelvey, of and at Canton, Ohio, and elsewhere;
Adolph Betzold, of and at St. Louis, Mo., and elsewhere;
Louis P. Valiquet, of and at the City of New York, and elsewhere;
— Reinhardt, of and at Camden, New Jersey, and elsewhere;
Alfred C. Clark, of and at Philadelphia, Pa., and elsewhere, whose present address is Paris, France,

and others whose names and addresses are to this defendant now unknown, but which, when ascertained it prays leave to insert in this Answer, and therefore the said patents are void and of no effect in law.

And for a further and special defense this defendant shows *Fifth*, that the matters and things and alleged combinations disclosed in and by the claims of the said Letters-patent and each of them, had been in public use and on sale in this country for more than two years before the date this defendant made application for patent thereon, to wit, by each of the persons named in the preceding paragraph of this Answer, and in addition by the following:

U. S. Gramophone Co., of Washington, D. C., at that place and elsewhere;

Berliner Gramophone Co., of Philadelphia, Pa., at that place and elsewhere;

Universal Talking Machine Co., of New York City, at that place and elsewhere;

National Gramophone Co., of New York City, at that place and elsewhere;

National Gramophone Corporation, of New York City, at that place and elsewhere;

American Talking Machine Co., of New York City, at that place and elsewhere;

Albert T. Armstrong, of New York City, at that place and elsewhere;

Joseph W. Jones, of New York City, at that place and elsewhere,

and others whose names and addresses are at present unknown to this defendant but which when discovered it prays leave of this Court to insert in this Answer; and therefore the said patents are void and of no effect in law.

And for a further defense, this defendant shows that in view of the state of the art disclosed by the before-mentioned patents and instances of prior knowledge and public use, the alleged improvements constituting the alleged inventions of this complainant, were at the date of his alleged invention thereof without novelty; and for the same reasons they were without invention; and for the same reasons they were wanting in patentability; wherefore the said patents are void and of no effect in law.

And for a further defense, this defendant shows that the apparatus and things dealt in by this defendant were made under and in accordance with improvements invented or discovered or produced by the said Louis

P. Valiquet, or that the same more nearly and closely resembled the said improvements made by the said Valiquet than they resembled the alleged improvements set forth in the patents here in suit; that on Dec. 19, 1898, the said Valiquet filed an application for the grant of U. S. Letters-patent covering his said inventions and improvements; that the said application became involved in interference proceedings with the pending application of this complainant which eventuated into the patents in suit; and that on May 5, 1900, by decision of the highest Tribunal in the Patent Office, reported in Vol. 92 of the Official Gazette of the U. S. Patent Office, pp. 1795-7, it was held that the apparatus and things and combinations set forth and disclosed in and by the said application of Valiquet did not, and could not, come within the terms of the claims of the said pending application of this complainant, which latter subsequently eventuated into the patents here in suit; and it was further decided in the same interference proceedings that the alleged improvements and arrangements set forth and claimed by this complainant (comprising or involving the subject-matter of the claims here in suit) consisted in supporting the diaphragm from the middle rather than from its periphery, and in having the diaphragm free at its periphery both adjacent to the two faces of the gaskets and at its cylindrical edge; —whereas, in the description as originally filed it was expressly stated by the said Eldridge R. Johnson that the said diaphragm was *supported* by the said rubber gaskets, was *held* by them, was under *tension* or *pressure* between the said rubber gaskets, and that there was contact between the said gaskets and the diaphragm; and that there has been no appeal from the said decision in the Patent Office, nor has the same ever been reversed or set aside; for which reasons this defendant avers that the question of infringement of the patents here in suit by the defendant's apparatus is now *res adjudicata* which has been finally decided in the neg-

ative, and the decision acquiesced in by this complainant.

And for a further defense this defendant, upon information and belief, avers that the apparatus and matters and things disclosed in and by patent No. 655,557, one of the patents here in suit, and attempted to be claimed by the same, are entirely distinct and separate from the apparatus and matters and things disclosed in and by patent No. 655,556, the other patent here in suit, and attempted to be claimed therein; that the aforesaid things described in the former are not used conjointly with the matters disclosed by the latter of said patents; and that therefore the infringement of the said two patents may not be set up in one Bill of Complaint.

All of which matters and things this defendant is ready and willing to prove as this Honorable Court shall direct, and it humbly prays to be hence dismissed with its reasonable costs and charges in this behalf most wrongfully sustained. *Columbia Phonograph Co. Inc.*

Dated Feb. 2, 1901.

By EDWARD D. EASTON, President
COLUMBIA PHONOGRAPH COMPANY, GENERAL,

by EDWARD D. EASTON,

President.

Philip Mauro, Philip Mauro,
Solicitor for Defendant

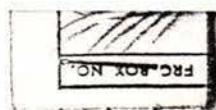
Office and Post Office Address,

Philip Mauro, 135 Broadway,
Cosmopolitan, New York City.

*Philip Mauro,
 E. A. L. Massie*

Of Counsel.

[17321]



IN THE CIRCUIT COURT OF THE UNITED STATES
FOR THE EASTERN DISTRICT OF PENNSYLVANIA.

Eldridge R. Johnson

vs.

Oct. Sess., 1900

No. 12

Columbia Phonograph Company, General.

Eldridge R. Johnson

V8

Oct Sess 1900

No. 13

National Gramophone Corporation

Dallas, J. The practice adopted in Russel vs. Winchester Arms Company, 97 Fed. Rep., 634, and followed in two instances in the Southern District of New York, is certainly exceptional. The propriety of its enforcement in those cases need not be questioned, but I have not been convinced that it should be insisted upon in those now before this court. Therefore, the defendant's motions to require the complainant to specify the claims relied on, are

Denied.

CIRCUIT COURT OF THE UNITED STATES

Eastern District of Pennsylvania.

October Sessions 1900, No. 12.

In Equity.

Eldridge R. Johnson,
Complainant,

vs.

Columbia Phonograph Company, General,
defendant.

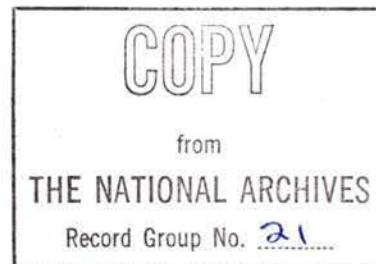
Before Dallas Cir J.

And now, to wit, this 4th day of June, 1902 upon
Motion of counsel for complainant, counsel for defendant
having been duly notified, but not appearing, it is

O R D E R E D that the complainant have leave to
dismiss his bill of complaint in this case filed, without
prejudice, and the said bill does hereby stand dismissed
without prejudice, the costs to be taxed by the clerk of the
Court.

By the court,





U.S. Circuit Court
Eastern District of Pennsylvania
Equity No. 12
October Session 1900